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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
TOLENTINO, RODERICK	

ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/092,354	KIM ET AL.	
	Examiner	Art Unit	
	Roderick Tolentino	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 July 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1 – 27 are pending.

Specification

[001]

The disclosure is objected to because of the following informalities: In the specifications misspelled word 'guaranty' should be fixed (para. 9 line 2).

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

[002] Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. See MPEP 2106:

[003] As per claim 1, the claimed invention is non-statutory subject matter since non-functional descriptive material is recorded on some readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must

be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in Abele, 684 F.2d at 907, 214 USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under copyright law.

[004] As to claims 2-7 all are rejected due to their dependency on the rejected claims and they fail to avoid the basis for which those claims are held non-statutory unpatentable.

Claim Rejections - 35 USC § 102

[005] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[006] Claims 1 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Bruekers et al. U.S. Patent No. (6,320,825).

[007] As per claim 1, Bruekers discloses remake content made based on at least one original content; (Col. 7 Line 55-57), original copyright information on the original content; (Col. 11 Line 47-50), remake copyright information on the remake content. (Col. 11 Line 29-34)

[008] As per claim 6, Bruekers discloses the remake content is recorded in at least one audio packet containing audio data (Col. 5 Line 19-24), and the original copyright information and the remake copyright information are recorded in a private header containing header information on the remake content(See Fig 6b)

[009] Claims 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaniwa et al. U.S. Patent No. (5,930,274).

[010] As per claim 24 Kaniwa discloses a reading unit to read copyright information on a remake content from said recording medium;(Col. 24 Line 41-43 and Col. 19 Line 52 through Col. 20 line 3), a processor to determine whether the remake content of the recording medium is reproducible, and if so, sends a command to said reading unit to read the remake content', (Col. 26 Line 34-37, Col. 19 line 15-28, reproduction digital signal) and a reproducing unit to receive and produce the remake content if said

processor sends the command to read the remake content to said reading unit. (Col. 25 Line 19-21)

[010] As per claim 25 Kaniwa discloses a decoding unit to decode the remake content received.(Fig. 1 Item 32)

[011] Claim 27 is rejected under 35 U.S.C. 102(b) as being anticipated by Fuchigami et al. U.S. Patent No. (5,960,274).

[012] As per claim 27 Fuchigami discloses a method determining whether remake content of a recording medium is reproducible: (Col. 5 Line 54, allowable copies)

Sending a command to read the remake content from the recording medium if the remake content is determined to be reproducible;

Reading the remake content if the command to read the remake content is sent;

And reproducing the remake content if the remake content is read.(Col. 2 Line 35-38)

Claim Rejections - 35 USC § 103

[013] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

[014] Claims 2, 3, 4, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruekers et al. U.S. Patent No. (6,320,825) in view of Fuchigami et al. U.S. Patent No. (5,960,398).

[015] As per claim 2 Bruekers et al. ('825) fail to disclose copyright information which includes a producer code and identification code. However, Fuchigami et al ('398) disclose remake copyright information which includes a producer code (Fuchigami et al., Col. 5 Line 51) of an apparatus used in making the remake content, and an identification code (Fuchigami et al., Col. 5 Line 50, ID code) of the apparatus.

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to use producer and identification codes with Bruekers copyright information because of the need for copyright protection (Fuchigami, Col.1 Line 33-35).

[016] As per claim 3, Bruekers as modified disclose Copyright information which further includes encoding information (Bruekers, Col. 11 Line 45-46, compression code) by which a reproducing apparatus can determine whether reproducing the remake content is possible.

[017] As per claim 4, Bruekers as modified disclose remake copyright information, which further includes the version of the remake copyright information (Bruekers et al., Col 11 line 31, version info)

[018] As per claim 5, Bruekers as modified teaches copyright information that includes the amount of allowable copies are to be made (Fuchigami, et al., Col 5 Line 54, allowable copies).

[019] As per claim 7, Bruekers as modified disclose copyright information where the original copyright information includes country code, an owner code, a year code, a year of recording and a serial number (Bruekers et al., Col. 11 Line 59).

[020] Claims 8, 9 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Timis et al. U.S. Patent No. (5,792,971) in view of Bruekers et al. U.S. Patent No. (6,320,825)

[021] As per claim 8 Timis et al. ('971) disclose making a remake content based on at least one original content (Col. 4 Lines 13-15,orginal content), recording the remake content on the recording medium; (Col. 13 Line 37-38,medium).

Timis et al. fail to teach the recording of original copyright information on the original content and remake copyright information on the remake content on the recording medium. However, Bruekers discloses original copyright information on the

original content; (Col. 11 Line 47-50, original copyright) and remake copyright information on the remake content. (Col. 11 Line 29-34, remake copyright)

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to use Bruekers copyright information for original content and remake content with Timis method for editing digital like audio information because it offers the advantage of copyright protection on the content on the disc. (Bruekers, Fig. 6B, list of information on a track including copyright information).

[022] As per claim 9 Timis as modified ('971) disclose the making of a remake content, the remake content is made by sampling the original content. (Timis, Col. 4 Line 13,orginal content)

[023] As per claim 12 Timis as modified ('971) disclose the original content includes audio or video data (Col. 4, Line 1-2, audio data).

[024] As per claim 13 Timis as modified teaches in their system both a method of recording their compressed data to audio packets while placing copyright information in a private section of the medium with no audio packets. (Bruekers, Fig. 6B , list of information on a track including copyright information).

[025] Claims 14 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Timis et al. (5,792,971) and Bruekers U.S. Patent No. (6,320,825), as applied to claims 8 and 13, in further view of Fuchigami et al. (5,960,398).

[026] As per claim 14 Timis as modified fails to disclose the remake copyright information including a producer code of an apparatus used to make the remake content and an identification code of the apparatus. However, Fuchigami et al. disclose a copyright data including and identification code and producer code (Fuchigami et al., Col. 5 Line 50-54, id and producer codes).

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to use producer and identification codes with Timis's system for editing digital audio information because of the need for copyright protection (Fuchigami, Col.1 Line 33-35).

[027] As per claim 22 Timis as modified fails to disclose the recording includes decrementing the number of remakes and recording the decremented number as copyright remake content. However Fuchigami et al. disclose copyright information including the amount of allowable copies to be from the medium (Fuchigami, Col. 5 Line 52-54).

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to use producer and identification codes with Timis's system for

editing digital audio information because of the need for copyright protection (Fuchigami, Col.1 Line 33-35).

[028] Claims 15, 16, 17, 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaniwa et al. U.S. Patent No. (5,930,274) in view of Fuchigami et al. U.S. Patent No. (5,960,398).

[029] As per claim 15 Kaniwa et al. ('274) discloses a converting unit to convert at least one original content into a remake content; (Col. 25, Line 19-21). Kaniwa discloses a processor to generate copyright information including original copyright information on the original content and remake copyright information. However, Kaniwa fails to disclose copyright information including identification information relating to said apparatus on the remake content. Fuchigami et al. ('398) disclose a copyright generation what includes identification of the apparatus (Col. 5, Line 50-52).

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to implement the Producer and Identification code of the remake apparatus with Kaniwa's reproduction apparatus because of the need for copyright protection (Fuchigami, Col.1 Line 33-35).

[030] As per claim 16 Kaniwa as modified discloses a decoder to decode the original content: (Fig. 1, Item 32) and an encoder to encode the original content decoded by the decoder into a remake content. (Col. 7, Line 23-27)

[031] As per claim 17 Kaniwa as modified teaches a reading unit to read the original content and the original copyright information from the recording medium. (Kaniwa, Col. 24, Line 41-43) and a copyright data generator (Fuchigami et al., Col. 5 Line 46-54, copyright generator).

One of ordinary skill in the art at the time of the applicant's invention would have clearly recognized that a copyright data generator would have been advantageous for recording/reproduction apparatus dealing with copyright protection. It is for this reason that one of ordinary skill in the art would have been motivated to add Fuchigami's copyright generator to Kaniwa's information recording/reproduction apparatus.
As per claim 19 Kaniwa as modified discloses copyright data including and identification code and producer code (Fuchigami et al., Col. 5 Line 50-54, id and producer codes).

[032] As per claim 20 Kaniwa as modified disclose copyright information that includes the amount of allowable copies are to be made (Fuchigami, et al., Col 5 Line 54, allowable copies).

[033] As per claim 21 Kaniwa as modified disclose that the original content includes audio data or video data and the original copyright information is an international Standard Recording Code (ISRC). (Fuchigami et al., Col. 5 Line 46-52).

[034] As per claim 16 Kaniwa as modified disclose a copyright data including and identification code and producer code (Fuchigami et al., Col. 5 Line 50-54, id and producer codes).

[035] Claims 18 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaniwa et al. U.S. Patent No. (5,930,274) and U.S. Patent No. Fuchigami et al. (5,960,398), as applied to claim 17 above, and in further view of Bruekers U.S. Patent No. (6,320,825).

Kaniwa et al. as modified fail to disclose the recording unit recording the original copyright information and the remake copyright information in a header in which header information on the remake content is recorded. However, Bruekers et al. ('825) disclose a Table of contents where copyright information is placed (Bruekers, Col. 11 Line 29-34).

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to use copyright data of the remake copyright information with original copyright information because it offers the advantage of copyright information on audio on digital information. (Fuchigami, Col. 1, Line 53-56, Copyright protection)

[036] As per claim 23, Kainwa as modified teaches copyright information including the amount of allowable copies to be from the medium (Col. 5 Line 52-54).

[037] Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Timis et al. U.S. Patent No. (5,792,971) in view of Kaniwa et al. U.S. Patent No. (5,930,274).

Timis et al. ('971) fail to disclose that during the making of a remake content, the remake content is made by a different coding method from a coding method by which the original content is made. However, Kaniwa et al. disclose an encoder that encodes the remake content by a different coding method (Kaniwa, Col. 7 Line 23 – 26).

At the time of the invention was made, it would have been obvious to a person of ordinary skill in the art to use a different encoder for the remake data, than the encoder used for the original content with system for editing audio information because it offers the advantage of preventing the adverse effect of code generation. (Kaniwa, Col. 7, Line 23-27, encoder advantage)

[038] Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Timis et al. U.S. Patent No. (5,792,971) and Bruekers U.S. Patent No. (6,320,825), as applied to claim 8 above and in further view of Ando et al. U.S. Patent No. (6,308,005).

Timis as modified fails to disclose that during the making of a remake content, the remake content is made by reading the original content from another recording medium and recording the original content in the recording medium different from the another recording medium. However, Ando et al. ('005), disclose a method of reading a medium (Col. 35, Line 45-46) and a recording method to a medium (Col. 35, Line 51-53).

At the time of the invention was made, it would have been obvious to a person of ordinary skill in the art to use a method to read and record information with a system for editing digital audio information because it offers the advantage of improving recording methods to other mediums. (Ando, Col. 1 Lines 8-12, improved recording methods)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roderick Tolentino whose telephone number is (571) 272-2661. The examiner can normally be reached between 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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